

REMARKS

The Examiner found the argument submitted with the applicant's appeal brief persuasive and withdrew the final rejection of June 10, 2005. The Examiner reopened prosecution and finally rejected all claims as anticipated by and obvious over new art, indicating that the applicant's amendment of March 29, 2005, necessitated new grounds of rejection.

The applicant respectfully traverses the finality of the new rejection. MPEP Section 706.07(a) provides that a second action on the merits shall be made final, except where the Examiner introduces a new ground of rejection that is not necessitated by the applicant's amendment. The section clarifies this requirement by stating that "... a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art." The section further states that "[A] second or any subsequent action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the

reason of incompleteness would be replied to by an amendment supplying the omitted element."

In the present case, both independent claims were amended to overcome Section 112 rejections. In addition, Claims 1 and 18 were amended to clarify language and to distinguish prior art on the basis of minor changes that clearly pertained to the invention as described throughout the specification. Specifically, Claim 1 further limited the original recitation of "tongues" to be also "one piece" and to have a major portion "which is pivotable." Both Claims 1 and 18 were amended to change "leg of the animal" to "hoof of the animal." With respect to Claim 18, this was the only substantive change.

Therefore, in view of the fact the applicant's invention deals with a horse boot with two tongues and is described throughout as such, it is respectfully submitted that these changes should reasonably have been expected to be made. This is particularly true with respect to Claim 18, wherein the indicated substantive amendment only changed the scope of the claim from "leg" to "hoof" of an animal, as might reasonably be expected in view of the equestrian nature of the invention.

Thus, in view of the requirements of MPEP Section 706.07(a) for proper final rejection, it is respectfully submitted that the finality of the new office action was premature. Accordingly, the applicant requests that the finality of the action be reconsidered and that the newly submitted amendment be entered.

The Examiner has now rejected Claims 1, 2, 10, 12, 15-20 under 35 USC 102(b) as anticipated by Adam (U.S. Patent No. 840,892), and all other claims as obvious over Adam in view of Dodd (GB 2,397,483), John (US 1,043,978) and Hammerstag (US 6,202,953). The Adam patent describes a horse shoe with a one-piece front tongue having a major portion pivotable with respect to the wall enclosing the boot support, and further with a one-piece rear tongue that is attached to and pivotable with respect to the support of the horse shoe.

The applicant has amended independent Claim 1 to set out the features distinguishing his invention from the reference. In particular, the front tongue of the applicant's boot is attached directly to the support, while the rear tongue is attached directly to the wall, opposite to the boot disclosed by Adam. Therefore,

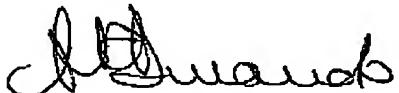
amended Claim 1 is not believed to read on the boot disclosed by Adam.

With regard to independent Claim 18, it recites "at least one band of elastic material connected to said tongue and to said wall." It is respectfully submitted that Adam does not disclose any such elastic structure. Neither the straps 8 and 9 nor the gores 11, which most closely correspond to the applicant's claimed elastic bands 36, are described as elastic. With regard to the straps 8,9, they are clearly not so because they are intended to be used with a buckle to strap the boot in place. With regard to the gores, a "gore" is defined in the dictionary as a triangular piece of cloth inserted in a garment to give greater width, without any mention to elasticity. Therefore, neither of these structures can be deemed to anticipate the claimed elastic straps on the basis of inherency, either.

In view of the foregoing, the applicant submits that Claim 1, as now amended, and Claim 18, as presented on appeal, are not anticipated by Adam and recite patentable subject matter. Therefore, the applicant respectfully requests that the finality of the action be withdrawn, as provided by MPEP Section 706.07(d), and that the rejection of Claims 1-20, as now amended, be reconsidered.

Please charge any cost associated with this response to our Deposit Account No. 04-1935.

Respectfully submitted,



Antonio R. Durando
Reg. No. 28,409
(520) 243-3383 phone
(520) 577-6988 fax